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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/705,533

11/10/2003

Abaneshwar Prasad

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10/30/2006

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/705,533

Applicant(s)

PRASAD, ABANESHWAR

Examiner

Michael A. Marcheschi

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/17/06 has been entered.

Claims 1-5, 13 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Bonsignore.

The reference teaches in the abstract, column 3, line 49-column 4, line 35 and example 1, biodegradable, transparent, self supporting, copolymer films (i.e. this is a solid polymer sheet) made from biodegradable polymers that has repeat units of lactic acid (PLA), such as L-PLA or D-PLA and/or glycolic acid

The preamble limitation "polishing pad " is of no consequence when a composition is the same. Ultimate intended utility does not make a composition patentable. See In re Pearson, 181 U.S.P.Q. 641

The examiner acknowledges that the reference is not literally directed to an polishing pad, however, applicants are claiming an "article or material" which the intended use does not carry any weight to the composition (see **In re Thuau 57 USPQ 324 (CCPA 1942)**). Any material possesses a property such that it may be used for a purpose. In addition, irrespective of what the material is called, the composition of the article is the same.

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In view of this, the claimed limitation “polishing pad”, although not literally defined by the reference, is defined by instant claim 1 as a solid polymer sheet, thus the limitation “polishing pad” means “a solid polymer sheet” and this is what the reference teaches. The instant claims are therefore anticipated by the reference because the reference teaches a composition which comprises all of the claimed components. In the alternative, no patentable distinction is seen to exist between the reference and the claimed invention absent evidence to the contrary.

Claims 1-8, 13 and 26-27 are rejected under 35 U.S.C. 103(a) as obvious over Mirsa et al. in view of Hirai et al. and Bonsignore.

Mirsa et al. teaches in the claims, a polishing pad comprising a polymer matrix (no specific one defined-see claim 2) and an abrasive (oxide or ceramic). The polymer is made by sintering (section [0016]), thus reading on a sintered polymer. This reference is silent as to the biodegradable polymer.

Hirai et al. teach in the abstract that that it is known to make burnishing pads out of biodegradable materials and that the use of biodegradable materials for the pad does not pollute environment after it is thrown away as waste.

The primary reference teaches a polishing pad made from a polymer matrix (no specific polymer defined, see claim 2, thus this reads on any polymeric material) and abrasives therein and it is the examiners position that one skilled in the art would have appreciated and thus found it obvious to use a biodegradable polymer as the polymer in the pad according to the primary reference because Hirai et al. teach that it is known to make burnishing pads (this can be broadly

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considered to be within the scope of a polishing pad since it accomplishes the same thing (polishes a surface to a high luster)) out of biodegradable materials in order to eliminate polluting the environment after it is thrown away as waste. One skilled in the art would have clearly appreciated that the use of any material which will optimize the environment to make an article (pad in this case) is beneficial to use. Assuming applicants argue that Hirai et al. is not a polishing pad, per se, this reference is only being applied to show that pads, irrespective of the use thereof, is known to be made out of biodegradable materials for environmental reasons. With the use of a biodegradable material obvious, as defined above, it is the examiners position that the skilled artisan would have appreciated that any known biodegradable material can be used, as long as it is a polymer (primary reference teaches that the pad must be made from a polymer). Bonsignore clearly teaches known biodegradable polymers, thus it is the examiners position that the skilled artisan would have appreciated that the biodegradable material, as a polymer, can include known biodegradable polymers as shown by this reference. With respect to the forms, Mirsa et al. teaches that the polymer is made by sintering (section [0016]), thus reading on a sintered polymer. In addition, because the reference clearly teaches that the article is in sheet form, it is a polymer sheet (i.e. solid since no porosity is defined in the independent claim 1).

Applicant's arguments filed 8/17/06, with respect to Bonsignore, have been fully considered but they are not persuasive.

With respect to applicant's arguments based on Bonsignore, it appears that applicant's argument is that this reference does not teach that the article is in one of the claimed forms. The

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examiner disagrees because the reference clearly teaches that the article is in sheet form (column 5, line 16), thus it is a polymer sheet (i.e. solid since no porosity is defined as previously defined in the previous office action). Applicant states that since the reference does not specifically teach a "polishing pad", it cannot constitute an anticipation rejection. In response to this, although the claimed limitation "polishing pad" is not literally defined by the reference, is defined by instant claim 1 as a solid polymer sheet, thus the limitation "polishing pad" means "a solid polymer sheet" and this is what the reference teaches.

With respect to the ODP rejection, application 10/705,121 is abandoned, thus this rejection is withdrawn.

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to teach or suggest this limitation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/06
MM

Michael A. Marcheschi
Primary Examiner
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